REMARKS

Claims 30-39, 41-50, 56, 57, 60-64, 107, 108, and 111-120 are pending in the present application.

At the outset, Applicants would like to thank Examiner for his time and consideration during the previous interview and Applicants provide the present reply to the outstanding Office Action in light of the discussions had during the interview.

In summary of the outstanding Final Office Action , claims 111-113, 116-118 and 120 stand rejected under 35 U.S.C. § 112. Claims 56, 107, 111, 119, and 120 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,619,247 to Russo. Claims 30, 31, 34-38, 43, 44, 50, 113-115, and 118 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. Claims 47-49 are rejected under 35 U.S.C. as being unpatentable over U.S. Patent 5,619,247 to Russo, WO 92/22983 to Browne et al. and U.S. Patent 6,249,532 to Yoshikaw et al. in view of U.S. Patent 5,905,713 to Anderson et al. Claims 33, 41, 45, and 116 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 6,177,931 to Alexander et al. Claims 39 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 6,522,769 to Rhoads et al. Claims 57, 60, 108, and 112 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,734,720 to Salganicoff. Claims 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of WO 92/22983 to Browne et al. Claim 117 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 5,483,278 to Strubbe et al.

Reconsideration of the outstanding objections and rejections to the claims is respectfully requested in view of the present amendments and following remarks.

Rejections under 35 USC § 112

Claims 111-113, 116-118 and 120 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement.

Regarding claims 111 and 112, the Office Action States "...the mechanism that automatically selects from the digital data content, makes said selection (of digital content) before the transmission and not after all of said digital data content is received at the user station as recited in the claim." The Office Action comes to this conclusion by relying on a portion of the patent application specification that describes the ID headers being read "on all of the broadcast movies and select for downloading to module 230 only those that are indicated as being desirable to the customer..." (page 22, lines 45-47). However, Applicants note that the broadcast content is actually described in the specification as being received at the user station at the download module 220 before being selected (automatically or otherwise) for storage in the storage module 230. Below are excerpts from the specification that provide support for this aspect of the invention.

> "The digital video content and program/pricing information, once received by the appropriate satellite, are then transmitted down broadly (i.e., "blanket transmitted") to geographic coverage areas where the user stations can receive the downlink transmissions via the user's satellite dish 24. Data is then transmitted to download module 220 contained in user station 228 where it is decoded and stored digitally in the storage module 230, preferably on a large disk drive..."
> Specification page 35, lines 2-11, Fig. 11.

As shown in Fig. 11, the download module 220 has a high speed memory buffer in which digital content is stored prior to being selected for storage in the separate storage module 230 to which the Office Action refers. Download module 220 also appears in Fig. 15 which corresponds to the description of the automatic selection as recited in claims 111 and 112. Thus, although the specification describes the headers of the broadcasted received digital data content being read in order for the automatic selection to take place, this is after

digital data content has been received (along with the header information) in the high speed memory buffer of the download module 220.

Therefore, Applicants submit that there exists support in the specification for claims 111 and 112 and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for these claims.

Regarding claim 113, it has been amended for clarification to recite "enables said selection only after all the digital data content of a particular program available for selection is received by the viewer." Support for this claim exists throughout the specification, and particularly on page 20, lines 47-49 which state "The customer therefore, at all times has immediate on-demand access to the movies in his storage module for viewing or permanent recording." Thus, in the particular example provided in the specification above, a movie is available for selection for permanent recording only once all of its content has been received and is in the storage module.

Therefore, Applicants submit that there exists support in the specification for claims 113 as amended and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for this claim.

Regarding claims 116-118, they have been amended to address the inconsistency noted in the Office Action and therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for these claims.

Regarding claim 120, it has been amended for clarification to recite "said selection is for permanent recording and is made only after all of said digital data content of a particular program is received at the location of the viewer." Support for this claim exists throughout the specification, and particularly on page 20, lines 47-49 which state "The customer therefore, at all times has immediate on-demand access to the movies in his storage module for viewing or permanent recording." Thus, in the particular example provided in the specification above, a movie is available for selection for permanent recording only once all of its content has been received and is in the storage module.

Therefore, Applicants submit that there exists support in the specification for claims 120 as amended and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for this claim.

Rejections under 35 USC § 102

Claims 56, 107, 111, 119, and 120 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,619,247 to Russo.

Regarding claim 56, the Office Action states "Russo teaches transmitting movies and music selections to customers... and automatically recording a movie." However, claim 56 recites "automatically selecting desired digital data content from the digital data content received." In contrast, Russo describes automatic recording based upon a particular time a movie is to be transmitted according to future schedule information, rather than based upon digital data content actually received. (Col. 9, lines 38-51). Thus, for at least the reasons above, Applicants submit that all the limitations of claim 56 are not taught or suggested by Russo.

Regarding claims 56 and 107, the Office Action states "Russo teaches downloading programs upon initial availability of a first-run movie." However, claim 107 recites a mechanism that "automatically selects from the digital data content for storage in a memory randomly on a periodic basis." Applicants respectfully submit that downloading upon initial availability of a first-run movie is not randomly. Thus, for at least the reasons above, Applicants submit that all the limitations of claim 107 are not taught or suggested by Russo.

Regarding claim 119, the Office Action states "Russo teaches transmitting content to the viewer and automatically selecting the movie for storage..." However, In Russo does not describe the actual data content for storage being transmitted until after the selection (automatic or otherwise) of the content for future storage Col. 9, lines 46-51. Particularly, Russo states "Yet a further option is for selections to be automatically downloaded based upon what has been previously viewed..." Col. 10, lines 4-5. Thus, in Russo, the automatic selection is made (based on previous viewing) and then the content is downloaded based upon that selection. In contrast, Claim 119 as amended recites "...transmits the digital data content to the viewer before selection of desired content for storage at a location of the viewer." Thus, for at least the reasons above, Applicants submit that all the limitations of claim 119 are not taught or suggested by Russo.

Therefore, for at least the reasons above, Applicants request the rejections of claims 56, 107, 111, 119, and 120 under 35 U.S.C. § 102(b) be withdrawn.

Rejections under 35 USC § 103

Claims 30-39, 41-50, 57, 60-64, 108, and 112-118 are rejected under 35 U.S.C. § 103(a).

Regarding claim 30, it is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. (Browne). The Office Action contends Browne teaches displaying a list of stored programs that may be locked by a user to prevent them from being erased or overwritten and that this equates to the claim 30 limitation of "a mechanism for the viewer to select desired digital data content for storage from the digital data content received by the viewer." However, according to Browne, marking a program as locked merely indicates that the program "will not be erased." (page 25, lines 26-27). In contrast, claim 30 describes the digital data content is selected for storage. Applicants submit that selecting an item for storage does not equate to marking an item already stored to "not be erased." Thus, for at least the reasons above, Applicants submit that all the limitations of claim 30 are not taught or suggested by either Russo or Browne.

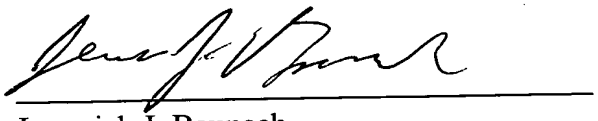
Claims 31-39, 41-50, 57, 60-64, 108, and 112-118 either depend directly or indirectly from claim 30, or were rejected for the same reasons as claim 30 with respect to elements they allegedly share in common. Thus Applicants submit that all the limitations of claims 31-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo for at least the same reasons presented above. Therefore, Applicants respectfully submit that all the limitations of claims 31-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo, Browne, the other reference cited by the Office Action, or any combination thereof, for the same reasons presented above for claim 30.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2142. Since all the limitations of claims 30-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo, Browne, the other references cited by the Office Action, or any combination thereof, for at least the reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) is earnestly solicited.

CONCLUSION

Applicants believe that the present reply is responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 30-39, 41-50, 56, 57, 60-64, 107, 108 and 111-120 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for the Examiner's continued rejection in light of the Applicant's arguments presented herein. Specifically, should the Examiner find the claims presented herein not to be allowable, Applicant's undersigned representative would respectfully request the Examiner to point Applicants to the column and line numbers in Russo where a viewer selects desired digital data content from the digital data content actually received by the viewer, as opposed to selecting from a schedule of future shows received by the viewer. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

Date: _____



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